REMARKS

In the non-final Office Action, the Examiner objected to the title as not descriptive;

rejected claims 1-7, 9-16, 18-22, and 25-30 under 35 U.S.C. § 102(e) as anticipated by <u>Birrell et</u>

<u>al.</u> (U.S. Patent No. 6,185,551); and rejected claims 8, 17, 23, and 24 under 35 U.S.C. § 103(a) as

unpatentable over <u>Birrell et al.</u> in view of <u>Maurille</u> (U.S. Patent No. 6,484,196).

By this Amendment, Applicants provide a new title that is indicative of the claimed

invention, cancel claim 30 without prejudice or disclaimer, amend claims 1, 7-10, 16-18, 22, 23,

25, 26, 28, and 29 to improve form, and add new claim 31. Claims 1-29 and 31 are pending.

Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102 and 103 with

regard to the claims as now amended.

At page 2 of the Office Action, the Examiner required a new title. Applicants provide

herewith a new title that is indicative of the claimed invention. Accordingly, Applicants

respectfully request that the Examiner withdraw the requirement for a new title.

At pages 2-6 of the Office Action, the Examiner rejected pending claims 1-7, 9-16, 18-22,

and 25-29 under 35 U.S.C. § 102(e) as allegedly anticipated by <u>Birrell et al.</u> Applicants

respectfully traverse the rejection.

Amended independent claim 1, for example, recites a combination of features of a

personal messaging agent. The personal messaging agent comprises a user profile configured to

store user preferences for processing messages, a message filter configured to receive a message,

perform in-band processing on the message based on the user preferences, and generate at least

one event for triggering out-of-band processing of the message based on the user preferences, and

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at least one external helper configured to perform the out-of-band processing of the messages in
response to the at least one event.

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every
aspect of the claimed invention either expressly or impliedly. Any feature not directly taught
must be inherently present. In other words, the identical invention must be shown in as complete
detail as contained in the claim. See M.P.E.P. § 2131. Birrell et al. does not disclose or suggest
the combination of features recited in amended claim 1. For example, Birrell et al. does not
disclose or suggest a message filter that is configured to, among other things, generate at least
one event for triggering out-of-band processing of a message based on user preferences for
processing messages.

The Examiner alleged that Birrell et al. discloses generating at least one event for
triggering out-of-band processing of a message and cited column 9, lines 25-40, of Birrell et al.
for support (Office Action, page 2). Applicants respectfully disagree.

At column 9, lines 25-40, Birrell et al. discloses:

Outputting, e.g., displaying or printing, a message removes the unread label 720 under
the assumption that it has been read. A user can explicitly add or remove the unread
label. A message can be deleted by attaching a "delete" label 730. This has the effect that
the message will not been seen again because messages labeled as deleted are normally
excluded during searches. Removing the deleted label has the effect of "un-deleting" a
message.

Although a preferred embodiment uses labels for data records that are mail messages, it
should be understood that "mutable" labels can also be used for other types of data
records. For example, labels which can be added and removed can be used with data
records such as Web-pages, or news group notes. The key feature here being that labels
are indexed in the same index as the record which they label, and that labels can be
added and removed.

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The Examiner alleged that the outputting, displaying, or printing disclosed by <u>Birrell et al.</u> is equivalent to the claimed generating at least one event (Office Action, page 2). Applicants respectfully disagree. <u>Birrell et al.</u> does not disclose or suggest that the outputting, displaying, or printing of a message by a user is an event that triggers out-of-band processing of the message based on user preferences for processing messages stored in a user profile, as required by amended claim 1.

The Examiner also alleged that removing an unread label disclosed by <u>Birrell et al.</u> is equivalent to the claimed triggering out-of-band processing (Office Action, page 2). Applicants again disagree. <u>Birrell et al.</u> does not disclose or suggest that removing an unread label associated with a message when the message is outputted, displayed, or printed is based on user preferences for processing messages stored in a user profile, as required by amended claim 1.

For at least these reasons, Applicants submit that claim 1 is not anticipated by <u>Birrell et al.</u> Claims 2-7 depend from claim 1 and are, therefore, not anticipated by <u>Birrell et al.</u> for at least the reasons given with regard to claim 1. Claims 2-7 are also not anticipated by <u>Birrell et al.</u> for reasons of their own.

For example, claim 4 recites that the message manager includes a plurality of message components corresponding to elements of the message, where each of the message components is configured to recognize a specific portion of the message and modify the specific portion based on the user preferences. <u>Birrell et al.</u> does not disclose or suggest these features.

The Examiner alleged that <u>Birrell et al.</u> discloses these features and cited column 9, lines 10-16, column 12, lines 25-29, and column 5, lines 60-67, of <u>Birrell et al.</u> for support (Office Action, page 3). Applicants respectfully disagree.

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At column 9, lines 8-16, <u>Birrell et al.</u> discloses:

Since operations on this structure are in-memory, updates for recent label mutations 660
can be relatively fast while the updating of the label index 650 can take place in
background.

As shown in FIG. 7, a message 700 includes a header 701 and a body. The header 701
typically includes the "To", "From", "Date" and "Subject" fields. The header may also
include routing information. The body 702 is the text of the mail message.

In this section, <u>Birrell et al.</u> discloses that a message includes a header and a body. Nowhere in

this section, or elsewhere, however, does <u>Birrell et al.</u> disclose or suggest a message manager that

includes a plurality of message components corresponding to elements of the message, where

<u>each of the message components</u> is configured to <u>recognize a specific portion of the message</u> and

<u>modify the specific portion based on the user preferences</u>, as recited in claim 4.

At column 12, lines 25-29, <u>Birrell et al.</u> discloses:

It should be noted, headers in Internet messages, depending on routing, can be quite
lengthy. Therefore, it is possible to restrict the view to just the "from," "to," "cc," "date,"
and "subject" fields of the header.

In this section, <u>Birrell et al.</u> discloses that the header fields presented to the user may be restricted

to the "from," "to," "cc," "date," and "subject" fields. Nowhere in this section, or elsewhere,

however, does <u>Birrell et al.</u> disclose or suggest a message manager that includes a plurality of

message components corresponding to elements of the message, where <u>each of the message</u>

<u>components</u> is configured to <u>recognize a specific portion of the message</u> and <u>modify the specific</u>

<u>portion based on the user preferences</u>, as recited in claim 4.

At column 5, lines 60-67, <u>Birrell et al.</u> discloses:

Filter queries can also be used to pre-sort messages received from particular mailing
lists. Query position information records which message the user last selected with a
query. This way the user interface can position the display of messages with respect to
the selected message when the query is reissued. User preferences 370 specify the

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appearance and functioning of the user interface to the mail service as implemented by
the extended browser.

In this section, Birrell et al. discloses that filter queries can be used to pre-sort messages.

Nowhere in this section, or elsewhere, however, does Birrell et al. disclose or suggest a message

manager that includes a plurality of message components corresponding to elements of the

message, where each of the message components is configured to recognize a specific portion of

the message and modify the specific portion based on the user preferences, as recited in claim 4.

For at least these additional reasons, Applicants submit that claim 4 is not anticipated by

Birrell et al.

Claim 5 recites that the message components include a header component configured to

process a header portion of the message, a separator component configured to process a separator

portion of the message, and a body component configured to process a body portion of the

message. Birrell et al. does not disclose or suggest these features.

The Examiner alleged that Birrell et al. discloses these features and cited column 9, lines

10-16, and Figure 7 of Birrell et al. for support (Office Action, pages 3-4). Applicants

respectfully disagree.

Column 9, lines 10-16, of Birrell et al. is reproduced above. Nowhere in this section, or

elsewhere, does Birrell et al. disclose or suggest a message manager that includes a header

component configured to process a header portion of the message, a separator component

configured to process a separator portion of the message, and a body component configured to

process a body portion of the message, as recited in claim 5.

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Figure 7 of <u>Birrell et al.</u> corresponds to a message 700. In connection with Figure 7,

<u>Birrell et al.</u> discloses:

> As shown in FIG. 7, a message 700 includes a header 701 and a body. The header 701
> typically includes the "To", "From", "Date" and "Subject" fields. The header may also
> include routing information. The body 702 is the text of the mail message.
>
> Each mail message can initially receive two labels, "inbox" 710 and "unread" 720.
> Messages labeled as "unread" 720 have not yet been exposed for reading. Messages with
> the "inbox" label 710 are deemed to require the user's attention. As will be described
> below, it is possible for messages to be labeled as unread but not have the inbox label.
> These less important messages can be read by the user as needed.

(col. 9, lines 12-24). Nowhere in this section, or elsewhere, does <u>Birrell et al.</u> disclose or suggest

a message manager that includes <u>a header component</u> configured to process a header portion of

the message, <u>a separator component</u> configured to process a separator portion of the message,

and <u>a body component</u> configured to process a body portion of the message, as recited in claim 5.

For at least these additional reasons, Applicants submit that claim 5 is not anticipated by

<u>Birrell et al.</u>

Amended independent claim 9 recites a combination of features of a system for providing

personal messaging services. The system comprises means for storing user preferences for

processing at least one message; means for receiving a message; means for performing in-band

processing on the message based on the user preferences to create a processed message; means

for generating at least one event for triggering out-of-band processing of the processed message

based on the user preferences; means for performing the out-of-band processing of the processed

message in response to the at least one event to create an enhanced message; and means for

providing the enhanced message for delivery to a message recipient.

Birrell et al. does not disclose or suggest the combination of features recited in amended claim 9. For example, Birrell et al. does not disclose or suggest means for generating at least one event for triggering out-of-band processing of the processed message based on the user preferences. This feature is similar to a feature recited in claim 1. Claim 9 is, therefore, not anticipated by Birrell et al. for reasons similar to reasons given with regard to claim 1.

Birrell et al. also does not disclose or suggest means for performing out-of-band processing of the processed message in response to the at least one event to create an enhanced message, which is then provided for delivery to a message recipient, as further recited in amended claim 9. The Examiner alleged that Birrell et al. discloses performing out-of-band processing of messages (changing label state) in response to at least one event (outputting, displaying, or printing) (Office Action, page 3). Birrell et al. discloses that an unread label associated with a message is removed in response to the outputting, displaying, or printing of the message (col. 9, lines 25-27). The outputting, displaying, and printing of a message occurs after the message has been delivered to a message recipient and, therefore, cannot be equated to the out-of-band processing that occurs prior to delivery, as recited in claim 9.

For at least these reasons, Applicants submit that claim 9 is not anticipated by Birrell et al.

Amended independent claims 10 and 18 recite features similar to features recited in claim 1 and/or claim 9. Claims 10 and 18 are, therefore, not anticipated by Birrell et al. for reasons similar to reasons given with regard to claim 1 and/or claim 9. Claims 11-16 and 19-21 depend from claims 10 and 18, respectively, and are, therefore, not anticipated by Birrell et al. for at least the reasons given with regard to claims 10 and 18. Claims 11-16 and 19-21 also recite features

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similar to features recited in claims 2-7. Claims 11-16 and 19-21 are, therefore, also not

anticipated by Birrell et al. for reasons similar to reasons given with regard to claims 2-7.

Amended independent claim 22 recites a combination of features of a message arrival

system. The message arrival system comprises a server configured to receive a plurality of

message streams from a plurality of message senders, where each of the message streams is

destined for one or more message recipients; a plurality of personal messaging agents configured

to receive the message streams from the server, perform in-band and out-of-band processing of

the message streams based on preferences of the one or more message recipients to create

enhanced message streams, and output the enhanced message streams; and a local delivery agent

configured to receive the enhanced message streams and deliver the enhanced message streams

as enhanced messages to one or more mailboxes of the one or more message recipients.

Birrell et al. does not disclose or suggest the combination of features recited in amended

claim 22. For example, Birrell et al. does not disclose or suggest a plurality of personal

messaging agents configured to, among other things, perform in-band and out-of-band processing

of message streams based on preferences of one or more message recipients to create enhanced

message streams.

The Examiner alleged that the in-band processing corresponds to parsing in Birrell et al.

and the out-of-band processing corresponds to removing an unread label in Birrell et al. (Office

Action, pages 2-3). Applicants disagree.

Claim 22 recites that the in-band and out-of-band processing of message streams are

based on preferences of one or more message recipients. These features are similar to features

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recited in claim 1. Claim 22 is, therefore, not anticipated by <u>Birrell et al.</u> for reasons similar to reasons given with regard to claim 1.

Claim 22 further recites that the personal messaging agents perform the in-band and out-of-band processing of the message streams before the message streams are delivered to one or more mailboxes of one or more message recipients by the local delivery agent. The "removing an unread label" described by <u>Birrell et al.</u> occurs after the message is delivered to the message recipient (col. 9, lines 25-27). Therefore, removing an unread label cannot be equated to the out-of-band processing recited in claim 22.

For at least these reasons, Applicants submit that claim 22 is not anticipated by <u>Birrell et al.</u> Claim 25 depends from claim 22 and is, therefore, not anticipated by <u>Birrell et al.</u> for at least the reasons given with regard to claim 22.

Amended independent claims 26 and 29 recite features similar to features recited in claim 22. Claims 26 and 29 are, therefore, not anticipated by <u>Birrell et al.</u> for reasons similar to reasons given with regard to claim 22. Claims 27 and 28 depend from claim 26 and are, therefore, not anticipated by <u>Birrell et al.</u> for at least the reasons given with regard to claim 26.

At pages 6-8 of the Office Action, the Examiner rejected claims 8, 17, 23, and 24 under 35 U.S.C. § 103(a) as allegedly unpatentable over <u>Birrell et al.</u> in view of <u>Maurille</u>. Applicants respectfully traverse the rejection.

Claims 8, 17, 23, and 24 variously depend from claims 1, 10, and 22. Without acquiescing in the Examiner's rejection, Applicants submit that the disclosure of <u>Maurille</u> does not cure the deficiencies in the disclosure of <u>Birrell et al.</u> identified above with regard to claims 1, 10, and 22. Therefore, claims 8, 17, 23, and 24 are patentable over <u>Birrell et al.</u> and <u>Maurille</u>,

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whether taken alone or in any reasonable combination, for at least the reasons given with regard to claims 1, 10, and 22.

New claim 31 depends from claim 29 and recites that the in-band and out-of-band processing are performed in parallel and prior to providing the e-mail message for delivery to the e-mail recipient. Neither <u>Birrell et al.</u> nor <u>Maurille</u>, whether taken alone or in any reasonable combination, discloses or suggests these features. For at least these reasons and the reasons given with regard to claim 29, Applicants submit that claim 31 is patentable over <u>Birrell et al.</u> and <u>Maurille</u>.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

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